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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,908	08/18/2000	Thomas J. Perkowski	100-040USA000	6782

7590 05/15/2003
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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,908

Applicant(s)

PERKOWSKI, THOMAS J. *ES*

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/18/00 & 02/23/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary amendment A, paper # 4 received on 02/23/2001 is acknowledged and entered. Claims 1-2 and 9-16 have been canceled and claims 3-8 have been amended. Currently claims 3-8 are pending for examination.

Priority

2. The examiner acknowledges the applicant's claim that the instant application is a Continuation-in-Part of co-pending applications/earlier filed applications by the same applicant (see page 1, lines 17-34). However, the subject-matter/limitation of the claims in the instant application of managing UPN/URL/Trademark/ Product-Descriptor data links within a manufacturer's enterprise is not supported by the said co-pending applications/earlier filed applications by the same applicant (see page 1, lines 17-34), and, therefore the filing date of the instant application will only be considered for prior art rejection.

Specification

3.1 The abstract of the disclosure is objected to because of undue length. Correction is required. See MPEP § 608.01(b). See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.

3.2. Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words -may not contain more than 500 characters.

3.3. The specification is objected to because it specifies that the instant application is related to a co-pending application serial # 09/284,197 and that is incorrect as the instant application and the cited co-pending application 09/284,197 do not have common inventor(s) or disclosure (see specification page 1). The examiner believes that it is a typographical error and # 09/284,197 should be replaced by 09/284,917. Correction is required.

Claim Rejections - 35 USC § 101

4 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.1 Method claims 3, 5, and 7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Claims 3, 5, and 7 recites the use of managing UPN/URL/ Trademark/ Product-

Descriptor data links within a manufacturer's enterprise, but, the claim does not set forth any steps involved in the method/process.

4.2 Apparatus claims 4, 6, and 8 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Apparatus claims have to define the boundaries of the structural elements for which the protection is sought. Since no structural elements of the apparatus claims 4, 6, and 8 are recited the disclosed invention is inoperative and therefore lacks utility.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.1 Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.2 The claims 3, 5, and 7 are generally narrative and indefinite, failing to conform with current U.S. practice. Claims 3, 5, and 7 provide for the use of managing UPN/URL/ Trademark/ Product-Descriptor data links within a manufacturer's enterprise, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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5.3 The claims 4, 6, and 8 are apparatus claims but it is unclear to what the apparatus comprises, i.e. what are the structural elements of the apparatus. See MPEP 2106, II, C, Review the Claims: "...The claims define the property rights provided by a patent...goal of claim analysis is to identify the boundaries of the protection sought.....". The cited inventions in claims 4, 6, and 8 do not define the boundaries of the structural elements of the apparatus for which the protection is sought.

5.4 Note: In view of the above rejection of claims 3-8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, as best understood by the examiner, the claims are directed to a method and apparatus to manage UPN/URL/Trademark/Product-Descriptor data links within a manufacturer's enterprise. Prior art rejection will be analyzed on this basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1 Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,490,567 (Gregory) and further in view of US 6,298,341 (Mann et al.), hereinafter, referred to as Mann.

With regards to claims 3-8, Gregory teaches a method and an apparatus to manage UPN/URL/Product-Descriptor data links by connecting UPC numbers/product-descriptors from the locally maintained UPC-indexed sales product price catalog (see at least col.4, line 53 -col.6, line 36, "... Commerce server data comprises summary data on the products offered.....includes product numbers, product category sizes.....prices, and a link to the appropriate merchant content server...several product information fields including a product identification number (SKU) field 711....manufacturer 713; product name 714; list price 715; offer price 716.....Generally, the URL of the merchant content server is provided to the commerce server....". Note: product numbers/SKU correspond to UPN.).

Gregory does not disclose managing Trademarks data links. However, Mann teaches managing trademarks data links (see at least, col.1, lines 26-33, "...Many domain namescorrespond to famous trademarks....". Note: Here trademark is being used to access content site). In view of Mann, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine Mann's teachings of using trademark data links because it will help to access content sites of the products related to trademarks by knowing trademarks only.

Gregory/Mann does not disclose that the above system is being used within a manufacturer's enterprise. Since the manipulative steps and structural elements of collecting and storing data and linking them with the URL would remain the same if they are to be used within a manufacturer's enterprise, it would be obvious to use the above system within a manufacturer's enterprise because it will help the

employees/departments within the manufacturer's company to use the above database to retrieve more information on a product or the supplier of that product by referring to the content server, as explicitly disclosed in Gregory/Mann (see Gregory at least col.2, lines 48-56).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US patents 6,532,481 to Fassett Jr. (see at least), 6,526,449 to Philyaw et al. (see at least), 6,199,048 to Hudetz et al. (see at least), 6,154,738 to Call (see at least), 5,992,752 to Wilz, Sr. et al. (see at least), discloses a method and an apparatus to manage UPN/URL/Product-Descriptor data links so that by cross-referencing product numbers/product descriptors with URL from a database an user can access content site. Further, all of these patents can be used in combination with Mann to render claims 3-8 unpatentable and obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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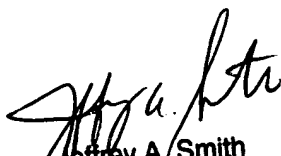
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305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
May 12, 2003


Jeffrey A. Smith
Primary Examiner